

REMARKS

Claims 1-34 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments below.

I. Rejection of Claims 1-3, 5-11 and 13- 34 Under 35 U.S.C. §102(b)

Claims 1-3, 5-11 and 13-34 stand rejected under 35 U.S.C. §102(b) as being anticipated by Castleman, *et al.* (US 5,508,691). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Castleman, *et al.* does not teach or suggest *each and every element* of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention generally relates to controlling dangerous equipment based on an analysis of electronic data stored in an electronic key. Independent claims 1, 18, 23, 24, 29 and 33 recite similar limitations regarding employing an electronic key with electronic key data stored therein, wherein a data *analyzer* is employed to *analyze* the electronic key data and *generate a control data based on the analysis* that can be utilized to control dangerous equipment. Such electronic key data includes key identifying information; key holder identity information; key holder medical information; key holder equipment access permissions; key holder equipment qualifications; key holder supervisor contact information; key holder security information, and key holder task, for example. Castleman, *et al.* does not teach or suggest such claimed aspects. Rather, Castleman, *et al.* discloses an electronic lock that *compares* a key code from an electronic key with pre-stored key codes in a lock to determine whether the read key code is authorized to toggle (open/close) the lock.

In the Advisory Action (dated December 31, 2003), the Examiner concedes that Castleman, *et al.* **compares** a read key code with pre-stored authorized key codes to determine whether the read key code is an authorized code (it matches a pre-stored code) or not (it doesn't match any pre-stored code). The Examiner then asserts that this comparison is synonymous to analyzing electronic key data as recited in the subject claims. However, comparing key codes as disclosed in Castleman, *et al.* is **not** synonymous with analyzing electronic key data as recited in the subject claims. As defined in Merriam-Webster's online dictionary, the infinitive "to compare" means "to examine the character or qualities of especially in order to discover resemblances or differences." (<http://www.merriam-webster.com>). Thus, with comparing entities, the goal is to decipher whether the entities resemble or differ from one other, which is precisely what Castleman, *et al.* attempts to accomplish by comparing key codes. Synonyms of compare include contrast and collate. (<http://www.merriam-webster.com>).

The definition of the infinitive "to analyze" is "to study or determine the nature and relationship of the parts of by analysis," wherein "analysis" is a "separation of a whole into its component parts." (<http://www.merriam-webster.com>). Synonyms of analyze include dissect and breakdown. (<http://www.merriam-webster.com>). Accordingly, Castleman, *et al.* discloses **comparing** (not analyzing) key codes; Castleman, *et al.* compares read and pre-stored key codes for resemblances and differences. Where a read key code resembles a pre-stored key code, the read key code is deemed authorized and the associated key can toggle the lock, and where a read key code does not resemble (is different from) a pre-stored key code, the key is deemed unauthorized and denied access to the lock. Thus, in light of the Castleman, *et al.* and the dictionary definitions of the terms compare and analyze, Castleman, *et al.* does not disclose analyzing electronic key data as recited in the subject claims.

The Examiner relies on an incorrect interpretation of the term comparison to read, *via inherency*, a data analyzer into Castleman, *et al.* Specifically, the Examiner states that since key codes are compared, an analysis is performed and, therefore, such comparison is *inherently* performed by a data analyzer. (Final Office Action, No. 5, p.4). However, this interpretation of compare and analyze is inconsistent with the dictionary definitions; the definitions clearly illustrate that compare and analyze are **not** synonyms, and, therefore, the *inherency* conclusion drawn by the Examiner is erroneous. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill.”” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The fact that a characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was [not] based on … what was necessarily present in the prior art). Since Castleman, *et al.* does not disclose analyzing data, as recited in the subject claims, but instead discloses comparing key codes, the missing descriptive matter (a data adapter that analyzes electronic key data) is *not* necessarily present and wouldn’t be recognized by persons of ordinary skill. Thus, contrary to the Examiner’s contention, Castleman, *et al.* does not disclose, expressly or inherently, a data analyzer, as recited in the subject claims.

Moreover, since Castleman, *et al.* does not disclose a data analyzer or analyzing electronic data, Castleman, *et al.* cannot disclose utilizing such analysis to generate control data that controls dangerous equipment, as recited in the subject claims.

In view of the foregoing, it is respectfully requested that this rejection of claim 1-3, 5-11 and 13-34 be withdrawn.

II. Rejection of Claims 4 and 12 Under 35 U.S.C. §103(a)

Claims 4 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Castleman, *et al.* (US 5,508,691) in view of Mabuchi, *et al.* (US 6,417,760). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Castleman, *et al.* and Mabuchi, *et al.*, individually or in combination, do not teach or suggest all limitations of the subject claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP §2143.

Claims 4 and 12 depend from independent claim 1, and Mabuchi *et al.* does not make up for the aforementioned deficiencies of Castleman, *et al.* regarding analyzing electronic key data obtained from an electronic key and employing the analysis to generate data to control dangerous equipment. Rather, Mabuchi *et al.* discloses an apparatus for inspecting target equipment and displaying the inspection information. Accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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